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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,512	06/23/2003	Thauming Kuo	71630	9715

7590 05/18/2006

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Eastman Chemical Company
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,512

Applicant(s)

KUO ET AL.

Examiner

Patrick D. Niland

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2, 4-15, and 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment of 2/9/06 has been entered. Claims 1-2, 4-15, and 17-33 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-15, and 17-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6262149 Clark et al..

Clark discloses the instantly claimed compositions and methods at the abstract; column 2, lines 35-67, particularly 54-67; column 3, lines 1-67, particularly 1-3 and 41-65; column 4, lines 1-67, particularly 25, 39, and 59; column 5, lines 1-67, particularly 1-19; column 6, lines 1-67, particularly 15-25; column 7, lines 1-67, particularly 1-27; column 8, lines 1-67, particularly 24-67; column 9, lines 1-67; column 10, lines 1-67, particularly 19-33 and 55-67; column 13, line 66 to column 14, lines 1-67, which falls within the scope of the reactant amounts of the instant claims 2 and 15; column 15, line 1-67; and the remainder of the document. The endpoint of column 3, line 2 falls within the scope of the instantly claimed particle size which anticipates the instantly claimed particle size. The applicant has not provided probative evidence that the particle size range of this section is not achievable where the amount of alkyd and acrylate of the

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instant claims and Clark are used and Clark does not exclude any particle sizes based on amounts of alkyd and acrylate. All things would not be expected to be equal per the applicant's argument because the particle size is determined by many more parameters than amount of alkyd including but not limited to molecular weights of polymers formed, amounts of hydrophilic moieties including acrylic acids etc., cosolvents used, emulsifiers, etc. This argument by the applicant is therefore not persuasive. The patentee is not limited to its examples. Arguments relating only to examples and ignoring the other teachings of the patent are therefore not persuasive.

Unexpected and surprising results do not overcome anticipation. The argued amount of alkyd and acrylate have endpoints falling within the scope of the instantly claimed ranges which anticipates these ranges. See MPEP 2131.03 II. One clearly envisions the endpoints of the prior art range and the instant prior art discloses ranges having an endpoint falling within the scope of the instantly claimed ranges which constitutes disclosing the instantly claimed invention with sufficient specificity. This rejection is therefore maintained.

5. Claims 1-2, 4-15, and 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6262149 Clark et al..

Clark discloses the instantly claimed compositions and methods at the abstract; column 2, lines 35-67, particularly 54-67; column 3, lines 1-67, particularly 1-3 and 41-65; column 4, lines 1-67, particularly 25, 39, and 59; column 5, lines 1-67, particularly 1-19; column 6, lines 1-67, particularly 15-25; column 7, lines 1-67, particularly 1-27; column 8, lines 1-67, particularly 24-67; column 9, lines 1-67; column 10, lines 1-67, particularly 19-33 and 55-67; column 13, line 66 to column 14, lines 1-67, which falls within the scope of the reactant amounts of the instant claims 2 and 15; column 15, line 1-67; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art to use the instantly claimed combinations of ingredients and amounts thereof because they are encompassed by the patentee and would have been expected to give coatings having the properties described by the patentee.

The endpoint of column 3, line 2 falls within the scope of the instantly claimed particle size which anticipates the instantly claimed particle size. The argued amount of alkyd and acrylate have endpoints falling within the scope of the instantly claimed ranges which anticipates these ranges. See MPEP 2131.03 II. One clearly envisions the endpoints of the prior art range and the instant prior art discloses ranges having an endpoint falling within the scope of the instantly claimed ranges which constitutes disclosing the instantly claimed invention with sufficient specificity. The applicant has not demonstrated unexpected results nor surprising results in a manner commensurate in scope with the instant claims and the cited prior art. The applicant has not provided probative evidence that the particle size range of this section is not achievable where the amount of alkyd and acrylate of the instant claims and Clark are used and Clark does not exclude any particle sizes based on amounts of alkyd and acrylate. All things would not be expected to be equal per the applicant's argument because the particle size is determined by many more parameters than amount of alkyd including but not limited to molecular weights of polymers formed, amounts of hydrophilic moieties including acrylic acids etc., cosolvents used, emulsifiers, etc. This argument by the applicant is therefore not persuasive. The patentee is not limited to its examples. Arguments relating only to examples and ignoring the other teachings of the patent are therefore not persuasive. This rejection is therefore maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

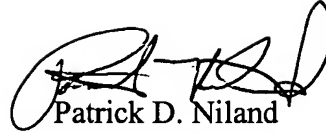
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland
Primary Examiner
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